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In re Application of
DOUGLAS, Paul
U.S. Application No.: 10/550,036
PCT No.: PCT/GB2004/001185
Int. Filing Date: 18 March 2004
Priority Date: 21 March 2003
Attorney Docket No.: 7881.18
For: JAW CRUSHER

DECISION

This decision is in response to the "Renewed Petition Under 37 CFR §1.47(a)" submitted on 07 February 2008.

BACKGROUND

On 26 December 2007, a decision dismissing applicant's petition under 37 CFR 1.47(b) was mailed. Applicant was given two months to respond with extensions of time available under 37 CFR 1.136(a).

On 07 February 2008, applicant filed a renewed petition under 37 CFR 1.47(b) which contained, *inter alia*, a Witness Statement by Martin Mark Neilson (Exhibit A) with accompanying attachments (a) - (bb) and Exhibits B - D containing a Witness Statement and Legal Memorandum by Mr. Ian Frazer English.

DISCUSSION

As previously noted, a petition under 37 CFR 1.47(b) requires (1) a petition fee, (2) factual proof that the inventor refuses to execute the application or cannot be located, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Items (1), (3) and (6) of 37 CFR 1.47(b) have previously been completed.

Regarding item (2) of 37 CFR 1.47(a), applicant failed to provide copies of the correspondence with the nonsigning inventor's counsel, Walker Morris, concerning the subject application. As a result, this item was not yet satisfied.

In the renewed petition, applicant has provided the requested documents and also submitted another Witness Statement by Mr. Neilson explaining his position in this matter. A review of the evidence and Witness Statement shows that the letter from Walker Morris dated 26 September 2007 states that Mr. Douglas would be willing to sign the applicable documents if the assignee pays the nonsigning inventor the sum of £4,096.58. The assignee states that Mr. Douglas is being unreasonable and uncooperative with this demand and refuses to pay.

37 CFR 1.47 does not require petitioners to pay inventors to sign required Declaration. That is a private matter between the parties. The evidence submitted provides a sufficient basis to conclude that Mr. Douglas's conduct constitutes a refusal to join. See § 409.03(d) MPEP. Petitioners previously submitted evidence showing that a complete copy of the subject application was presented to the nonsigning inventor on 07 September 2007.

Item (2) of 37 CFR 1.47(a) is now satisfied.

Regarding item (4), the 37 CFR 1.47(b) applicant provided a declaration listing the name, residence, mailing address and citizenship of the sole inventor. The new declaration was signed by Ian Frazier English, Solicitor and Chief Legal Counsel of Extec Screens and Crushers Limited on behalf of the inventor. Mr. Evan R. Witt states in the petition that "[a]pplicants submit that Mr. English has authority to sign the Declaration on behalf of the assignee." This statement is sufficient to demonstrate that Mr. English has the authority to sign for the 37 CFR 1.47(b) applicant. See 37 CFR 3.73(b)(2)(I). A review of the declaration shows that the declaration meets the requirements of section 409.03(b) of the MPEP and is in compliance with 37 CFR 1.497(a) and (b). Item (4) of 37 CFR 1.47(b) is complete.

With regards to item (5), the prior decision noted that "the 37 CFR 1.47(b) applicant has not provided a statement of a person having firsthand knowledge of the facts that the invention was made by Mr. Douglas in the scope of his duties while employed by the 37 CFR 1.47(b) applicant (or assignee)." In addition, it was also not clear whether the assignment submitted in the 18 September 2007 petition applies to the subject application. The decision noted that a legal memorandum prepared by an attorney familiar with the law of the jurisdiction involved may be required to certify that the subject invention was transferred to the 37 CFR 1.47(b) applicant.

In the renewed petition, applicant submitted a legal memorandum by Mr. Ian Frazer English, a Solicitor and Chief Legal Counsel to the 37 CFR 1.47(b) applicant. Mr. English confirms that the subject invention was made by Mr. Douglas during his employment by "predecessor companies of Extec Screens and Crushers Limited." This statement is acceptable.

10/550,036

Mr. English also affirms that the rights in the above-captioned application were transferred by assignment to Extec Screens and Crushers Limited (a copy of this assignment was previously furnished). Moreover, Mr. English concludes that under United Kingdom law that all rights and title to the subject application are transferred from Paul Douglas to Extec Screens and Crushers Limited. In the Witness Statement, Mr. English explains which British statute (U.K. Patents Act 1977, Section 39(1)) was relied upon to make his determination. This memorandum meets the requirements of section 409.03(f) of the MPEP. The 37 CFR 1.47(b) applicant has demonstrated sufficient proprietary interest in the subject application. Item (5) of 37 CFR 1.47(b) is complete.

Accordingly, the 37 CFR 1.47(b) applicant has now met all of the requirements of 37 CFR 1.47(b).

CONCLUSION

Applicant's renewed petition under 37 CFR 1.47(b) is **GRANTED**.

As provided in 37 CFR 1.47(b), a notice of the filing of this application will be forwarded to the non-signing inventor at the last known address of record as set forth in the papers filed 23 October 2007 and a notice of the filing of the application under 37 CFR 1.47(b) will be published in the Official Gazette.

Applicant has completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 18 March 2004 under 35 U.S.C. 363, and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 07 February 2007.

This application is being forwarded to the Office of Patent Applications Processing for continued processing.



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